

RemarksStatus of the Claims

Claims 1-32 are pending in the application. All claims stand rejected. By this paper, claims 1 and 15 have been amended. Reconsideration of all pending claims herein is respectfully requested.

Claim Rejections

Claims 1, 14, 15, and 28 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence et al. ("Lawrence"), Papadimitriou et al. ("Papadimitriou"), and Menard et al. ("Menard").

Claims 2, 3, 6, 16, 17, and 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Lauder et al. ("Lauder").

Claims 4 and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, Lauder, and Kusaba et al. ("Kusaba").

Claims 5 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, Lauder, Kusaba, and Sorensen.

Claims 7, 8, 21, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Maze et al. ("Maze").

Claims 9, 10, 13, 23, 24, and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Legall et al. ("Legall").

Claims 11, 12, 25, and 26 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Knudson et al. ("Knudson").

Claim 29 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Herz et al. ("Herz").

Claim 31 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Proehl et al. ("Proehl").

Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lawrence, Papadimitriou, Menard, and Cao et al. ("Cao").

These rejections are respectfully traversed as detailed below.

A. The Combination of Lawrence, Papadimitriou, and Menard Does Not Establish a Prima Facie Case of Obviousness for Claims 1 and 15

A rejection based on prior art – whether grounded in anticipation or obviousness – must account for each and every claim limitation. *Celeritas Techs. Inc. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998) (anticipation); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q.2d 494, 496 (CCPA 1970) (obviousness); MPEP § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") (emphasis added). As explained below, the combination of Lawrence, Papadimitriou, and Menard does not account for each and every claim limitation. Indeed, the references teach away from the claimed invention and from each other, negating the plausibility of the combination by one of ordinary skill in the art.

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1. References Do Not Disclose Registering User Requests for Information Other than for Program Content With a Cable Headend

The applicants argued in their previous response that neither Menard nor Papadimitriou discloses registering user requests at a cable headend. Specifically, the Examiner equated Menard's "accesTV" with the claimed cable headend. However, as argued, Menard merely discloses a video-caching server where requested television programs are cached before being delivered to users' PCs. Menard does not even mention the word "headend."

The Examiner apparently agreed with the applicants' argument because Lawrence is now being cited for the "cable headend." However, Lawrence has absolutely nothing to do with registering user requests for information at a cable headend, as claimed.

Lawrence allows a set top box to automatically (*i.e.*, without user intervention) obtain a printer driver from a cable head end. According to Lawrence,

the set top box first detects that a new printer driver is needed. For example, this detection may occur automatically when a new printer is plugged into the set top box or may occur by initiation from the user of the set top box. The set top box then sends a request over the digital cable network to the cable head end which receives the request. In the preferred mode, the request includes printer identification information such as manufacturer and model. The cable head end then determines the type of printer driver needed according to the information sent by the set top box. Also in the preferred mode, the cable head end possesses information regarding the set top box, such as the type of set top box hardware and the operating system being utilized in the set top box. The cable head end then obtains the needed printer driver, and sends the printer driver to the set top box, upon which the set top box loads the printer driver for subsequent use.

Lawrence at [0010] (emphasis added).

Lawrence's printer drivers are not remotely similar to the claimed "user requests for information." They have nothing to do with the *user*. They are downloaded automatically by the set top box in response to detecting that a new printer driver is needed. Indeed, Lawrence cites the advantages of eliminating the *user* from the driver installation process:

It would be preferable, therefore, to utilize connection between the set top box and the cable head end over the digital cable network to obtain a printer driver corresponding to the printer, therefore reducing the need for ... technical knowledge of the user to install the printer driver in the set top box.

Lawrence at [0009] (emphasis added). Far from helping a user register a user request for information, Lawrence seeks to avoid user input by automatically detecting the printer and then including an indication of the printer in a request sent to the headend. See [0010]. Accordingly, Lawrence teaches away from the claimed registration of *user requests* within a set top box.

The present application provides numerous examples of *user requests for information*. As stated in the specification, "the requested information may relate to a wide variety of topics, such as stock prices, ski conditions, weather conditions, flight information, school lunch menus, sporting scores, election results, and the like." Specification at page 4. These are clearly "user" requests for information, because they relate to information that a user might be interested in obtaining. No one of ordinary skill in the art would refer Lawrence's automatically downloaded printer drivers as "user" requests for information.

The claimed invention is not intended to cover all requests for non-program content, but only "user requests for *information* other than for program content." Indeed, set top boxes will often download operating system (OS) updates and the

like from a central server. However, these are likewise not "user requests for information," but are maintenance procedures designed to operate transparently to the user, contrary to "user request" language of claim 1.

The fact that other systems might process user requests does not render the claimed invention obvious in light of the teachings of Lawrence. Ordinarily, cable headends are not used for registering user requests for information and monitoring for non-program content on behalf of cable subscribers. The cable headend is responsible for distributing television signals to subscribers. It is also responsible for maintaining the set top boxes, which may include distributing OS updates and printer drivers to the set top boxes. Lawrence falls into this latter category of non-user-requested maintenance procedures that do not involve user input.

Menard and Papadimitriou both relate to searching for "program content," which is a function normally associated with cable headends. For example, Menard refers to searching for program sources for television programs. Col. 2, line 39 through col. 3, line 33. Likewise, Papadimitriou discloses caching multimedia programs, such as television programs. Thus, neither reference discloses registering a request for "other than for program content," as claimed. Indeed, by teaching requests for program content to the exclusion of non-program content, Menard actually teaches away from the claimed limitation of "other than for program content." Menard also teaches against Lawrence because Menard is about enabling user input, not avoiding it. Indeed, if Menard were modified with the teachings of Lawrence to make automatic requests that do not involve user input, his entire purpose would be frustrated.

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One of ordinary skill in the art would not be motivated to combine Lawrence, Papadimitriou, and Menard, given that each reference teaches away from the claimed invention, and from each other. Why would one of ordinary skill in the art be motivated to combine a known way to update a set top box's printer drivers from a cable headend (Lawrence) with a system for enabling a user to search for desired television programs (Menard)? The two references could not be more different.

2. References Do Not Disclose Monitoring at the Cable Headend Information Sources External to the Headend for a Triggering Event that is Separate from the Request Itself or Locating the Information

As amended, claim 1 recites "monitoring at the cable television headend one or more information sources external to the cable television headend for the triggering event." In the "Response to Arguments" section of the Office Action, the Examiner responded to the applicants' argument that Papadimitriou discloses triggering by a user request, as opposed to an external event, as follows:

[In Papadimitriou, the] user makes a request for a particular media program or 'the request' and the user also selects the times at which the user wishes to receive the multimedia program. This request as a whole merely causes the scheduler to schedule the delivery of the multimedia. The multimedia program is then delivered at the time the user request[s] by the server monitoring a clock or 'monitoring one or more information resources for the future triggering event.'"

Office Action, page 17 (emphasis added). In light of the foregoing amendment, this response is no longer valid. Such monitoring, as described by the Examiner, would involve monitoring an internal information source (the clock), rather than an information source external to the cable television headend, as claimed.

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All of the other references are about delivery criteria that is essentially the transmission of the request itself or the fact that information is found. For example, Menard states that "[w]hen a match is found, the search server 4 sends an alert signal back over the Internet to the address of the requesting PC." Col. 3, lines 26-28. However, this is merely delivery of the notification in response to locating the information, contrary to the requirements of amended claim 1. Lawrence has nothing to do with *user requests* for information, as described above. Even if he did, the delivery of the information would be in response to the automated request or in response to the driver being found in the cable headend, both of which are contrary to the limitation of claim 1.

3. Lawrence, Menard, and Papadimitriou Each Fail To Teach Elements of the Claimed Invention and Cannot Be Combined

As explained above, Lawrence, Menard, and Papadimitriou each fail to teach or suggest the limitation of "registering at a cable television headend a plurality of *user requests* for information *other than for program content*." Lawrence actually teaches against user requests. Menard and Papadimitriou teach away from "other than for program content." The combination of the two would be implausible given the fact that each reference teaches away from the claimed invention. Given that these elements are not taught or suggested in the prior art, a *prima facie* case of obviousness has not been established.

In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed." *Hartness International, Inc. v. Simplimatic*

Engineering Co., 819 F.2d 1100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987). Looking past the individual claim elements to the invention as a whole, one of ordinary skill in the art is struck with the fact that the cited references really having nothing to do with registering user requests for information at a cable headend to allow the cable headend to monitor external information sources for a triggering event separate from the request or merely finding the information, which event causes the requested to be delivered to the requesting users. Lawrence, in particular, is antithetical to the claimed invention because it seeks to avoid user requests, providing driver updates automatically when a new printer is detected.

In view of the foregoing, the applicant respectfully submits that claims 1 and 15 are patentably distinct. All other claims depend directly or indirectly from claims 1 and 15 and are therefore patentably distinct for at least the same reasons.

B. The Combination of Lawrence, Papadimitriou, Menard, and Maze Does Not Establish a Prima Facie Case of Obviousness for Claims 7, 8, 21, and 22

Claim 7 recites "receiving a user selection of a notification format for the delivered information." Claim 8 recites "notifying the user concerning the delivered information using the selected notification format." Claims 21 and 22 correspond to claims 7 and 8, respectively.

The Office Action agrees that Lawrence, Papadimitriou, and Menard do not receive "a user selection of a notification format for the delivered information." Office Action, page 8. However, the addition of Maze does not cure the deficiencies of these references.

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The Office Action points to FIG. 2 and column 3, lines 5-10 of Maze for the user selection of a notification format. However, Maze's FIG. 2 merely shows that the user may decide whether or not to display a notification, not what format the notification may take. For example, FIG. 2 illustrates a check box for "Display a 'Program Located' Message." If the box is not checked, no message will be displayed. The failure to display a message when the box is not checked cannot be deemed a "notification format." Furthermore, the "Program VCR to Record" checkbox does not comprise a "notification format," since it does not in any way alert the user at the time of the triggering event. The program may be broadcast in the distant future, in which case the user will only be "notified," if it can even be referred to as a notification, when the VCR begins to record at that future time.

At most, Maze only has a single notification format. If no choice is given, there can be no selection, as required by claims 7 and 8. By contrast, the present application refers to a number of different formats, e.g., pop-up alerts, tickers, e-mail messages, from which the user may select. Because Maze does not allow a user to specify a notification format, the applicants respectfully submit that a *prima facie* case of obviousness has not been established.

The applicants respectfully point out that Maze's "Display a 'Program Located' Message teaches away from the claimed limitation of "other than for program content." Maze only relates to program content and should not, therefore, be combined with Lawrence.

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C. The Combination of Lawrence, Papadimitriou, Menard, and Herz Does Not Establish a Prima Facie Case of Obviousness for Claim 29

Claim 29 recites that the triggering event comprises a change in stock price. The Office Action apparently agrees that Lawrence, Papadimitriou, and Menard do not disclose that the triggering event comprises a change in stock price, but cites Herz for this limitation. See Office Action, page 13.

Herz, however, merely notifies the user when a stock price reaches a certain level. In other words, the information communicated is merely the fact that the triggering event has occurred, similar to providing information once it has been found, contrary to the limitations of claim 1. Herz does not use the stock price for triggering the delivery of other, separately-located information, which satisfies a separately-registered "user request."

Herz makes the step of registering a "user request" recited in claim 1 completely superfluous because the triggering event (*i.e.*, the stock price reaching a threshold level) is the only thing the user is interested in. Herz's stock prices are not used as a triggering event for delivery of information found in a separate search to satisfy the recited "user request."

Because Herz does not use the stock price as a "triggering event" for "delivering" information found in a separate "user request," the applicants respectfully submit that a prima facie case of obviousness has not been established.

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D. The Combination of Lawrence, Papadimitriou, Menard, and Proehl Does Not Establish a Prima Facie Case of Obviousness for Claim 29

Claim 31 recites that the triggering event comprises the arrival of an e-mail message. The Office Action apparently agrees that Lawrence, Papadimitriou, and Menard do not disclose that the triggering event comprises the arrival of an e-mail message, but cites Proehl for this limitation. See Office Action, page 14.

Contrary to the Examiner's assertions, however, Proehl merely alerts the user when an e-mail message is received. In other words, the information communicated is merely the fact that the triggering event has occurred, similar to providing information once it has been found, contrary to the limitations of claim 1. Proehl does not use the arrival of an e-mail message for triggering the delivery of other, separately-located information, which satisfies a separately-registered "user request."

Proehl makes the step of registering a "user request" recited in claim 1 completely superfluous because the triggering event (i.e., the arrival of the e-mail message) is the only thing the user is interested in. The arrival of an e-mail message in Proehl is not used as a triggering event for delivery of information found in a separate search to satisfy the "user request."

Because Proehl does not use the arrival of an e-mail as a "triggering event" for "delivering" information found in a separate "user request," the applicants respectfully submit that a prima facie case of obviousness has not been established.

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E. The Combination of Lawrence, Papadimitriou, Menard, and Cao Does Not Establish a Prima Facie Case of Obviousness for Claim 29

Claim 32 recites that the triggering event comprises the arrival of an e-mail message from a particular user. The Office Action agrees that Lawrence, Papadimitriou, and Menard do not disclose that the triggering event comprises the arrival of an e-mail message, but cites Cao for this limitation. See Office Action, page 18.

Cao, however, merely alerts the user when an e-mail message from a particular user has been received. In other words, the information communicated is merely the fact that the triggering event has occurred, similar to providing information once it has been found, contrary to the limitations of claim 1. Cao does not use the arrival of an e-mail message from a particular user for triggering the delivery of other, separately-located information, which satisfies a separately-registered "user request."

Cao makes the step of registering a "user request" recited in claim 1 completely superfluous because the triggering event (i.e., the arrival of the e-mail message from the particular user) is the only thing the user is interested in. The arrival of an e-mail message in Cao is not used as a triggering event for delivery of information found in a separate search to satisfy the "user request."

Because Cao does not use the arrival of an e-mail from a particular user as a "triggering event" for "delivering" information found in a separate "user request," the applicants respectfully submit that a prima facie case of obviousness has not been established.

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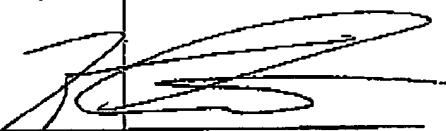
F. Conclusion

In view of the foregoing, all claims are believed to be in condition for allowance. If the Examiner disagrees, the applicant respectfully requests that the amendments be entered to place the claims in better condition for appeal.

Respectfully submitted,

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